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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,331	01/18/2005	Tetsujiro Kondo	450100-04682	9196
<div>7590 William S Frommer Frommer Lawrence &amp; Haug 745 Fifth Avenue New York, NY 10151</div>				
<div>10/07/2010</div>				
<div>EXAMINER</div>				
<div>RAO, ANAND SHASHIKANT</div>				
<div>ART UNIT</div>		<div>PAPER NUMBER</div>		
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<div>10/07/2010</div>		<div>PAPER</div>		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/521,331

**Applicant(s)**

KONDO ET AL.

**Examiner**

Andy S. Rao

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6, 24, 25, 34 and 35 is/are allowed.
- 6) ☐ Claim(s) 9-11, 26-28 and 36-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims pending in the application are 1-11,24-28,34-38,44-46,49-51,60-62,65-67,76-78,81-83,92-94,97-99,108-111,116-119,124-127 and 132-135.

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election without traverse of 7/15/10 of the embodiment of figure 1 as read on by claims 1-6, 9-11, 24-28, and 34-38 is acknowledged.

***Specification***

2. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 10-11, 27-28, 37-38 are rejected under 35 U.S.C. 101 because they are directed towards nonstatutory subject matter.

A). The Examiner notes that "for recording a program..." and "...a program..." does not specify how the instructions are (a) associated with the medium, or (b) the nature of instructions. Data structures not claimed as embodied (or encoded with or embedded with) in a computer readable medium are descriptive material per se, and are not statutory, *Warmerdam*, 33 F.3d at 1361, 31, USPQ2d at 1760). Similarly, computer programs claimed as computer listings, instructions, or codes are just the descriptions, expressions, of the program are not "physical things". They have neither computer

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components nor statutory processes, as they are not “acts” being performed. In contrast, a claimed “...computer readable medium encoded with a computer program...” is a computer element which defines structural and function interrelationships between the computer program and the rest of the computer, and is statutory, Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035. See Interim Guidelines, Annex IV (Section a).

Corrections to the claims, and supporting specification are required.

5. Claim 9, 26, 36, are rejected under 35 U.S.C. 101 as not falling within one of four statutory categories of inventions. Supreme Court precedent<sup>1</sup> and recent Federal Circuit decisions indicate a statutory “process” under 35 U.S.C. § 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing<sup>2</sup>. While the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. For example there is no apparatus mentioned either in the preamble nor in the subsequent limitations for executing the method, nor is the encoding of a ROI considered a transformation of the video signal, In re Bilski, 88 USPQ2d 1385 (Fed. Cir. 2008).

#### ***Allowable Subject Matter***

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<sup>1</sup> Diamond v. Diehr, 450 U.S. 175, 184, (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70, (1972); Cochrane v. Deener, 94 U.S. 780, 787-788 (1876).

<sup>2</sup> The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. Gottschalk v. Benson, 409 U.S. 63, 71 (1972).

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6. Claims 1-6, 24-25, and 34-35 are allowed.

Independent claims 1, 24, 34 are directed towards an apparatus and further includes "...data selection means for selecting multiple items of first informational data positioned in a periphery of a target position in the second informational signal, based on the first informational signal; class detection means for detecting a class to which informational data of the target position belongs, based on the multiple items of first informational data selected by the data selection means; correction data generation means for generating correction data for correcting an encoding noise, said correction data corresponding to the class detected by the class detection means; and correction means for performing correction processing by use of the correction data generated by the correction data generation means on second informational data among the multiple items of informational data that constitute the first informational signal, said second informational data corresponding to the target position in the second informational signal, to obtain informational data of the target position in the second informational signal..." which are features that are not anticipated nor obvious over the art of record. Dependent claims 2-6, 25, 35 are allowed for the reasons concerning the independent claims.

7. Claims 9-11, 26-28 and 36-38 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101 set forth in this Office action.

Independent claims 9-11, 26-28, 36-38 are directed towards a method and a computer readable medium and further include "...a first step of selecting multiple items of first informational data positioned in a periphery of a target position in the second informational signal, based on the first informational signal; a second step of detecting a class to which informational data of the target position belongs, based on the multiple

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items of first informational data selected by the first step; a third step of generating correction data for correcting an encoding noise, said correction data corresponding to the class detected by the second step; and a fourth step of performing correction processing by use of the correction data generated by the third step on second informational data among the multiple items of informational data that constitute the first informational signal, said second informational data corresponding to the target position in the second informational signal, to obtain informational data of the target position in the second informational signal..." which are features that are not anticipated nor obvious over the art of record.

### *Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lin discloses decoding macroblock type and coded block pattern information.
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andy S. Rao whose telephone number is (571)272-7337. The examiner can normally be reached on Monday-Friday 9AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mehrdad Dastouri can be reached on 571-272-7418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

asr

/Andy S. Rao/

Primary Examiner, Art Unit 2621

October 1, 2010